

REMARKS

The Official Action mailed July 9, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on October 17, 2006; August 13, 2007; and April 9, 2008.

The Applicant notes the *partial* consideration of the Information Disclosure Statement filed on August 16, 2006. Specifically, it appears that the Examiner inadvertently overlooked the citation of "International Search Report for Application No. PCT/JP2005/002107." A copy of the partially considered Form PTO-1449 is available in the Image File Wrapper under the heading, "List of References cited by applicant and considered by examiner" and has a mail room date of "07-09-2008." The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the "International Search Report for Application No. PCT/JP2005/002107."

Claims 1-7 were pending in the present application prior to the above amendment. Claim 7 has been canceled without prejudice or disclaimer, and claims 1, 3 and 6 have been amended to better recite the features of the present invention. Accordingly, claims 1-6 are now pending in the present application, of which claims 1, 3 and 6 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 7 under 35 U.S.C. § 101. Claim 7 has been canceled without prejudice or disclaimer; therefore, the above-referenced rejection is now moot.

Paragraph 4 of the Official Action rejects claims 1 and 2 as anticipated by EP 1 106 968 to Mannesmann. The Applicant respectfully submits that an anticipation

rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended. Specifically, independent claim 1 has been amended to recite "a route pattern generation unit adapted to generate all via-sequence patterns in each of which the specified locations are visited once in sequence" and "a calculation unit adapted to calculate an arrival time at each of the specified locations when successively visiting those locations in each of the via-sequence patterns generated by the route pattern generation unit while avoiding passing through congested places and/or places which may be congested in accordance with predetermined traffic information," which is supported in the present specification, for example, at page 22, lines 16-27. The Applicant respectfully submits that Mannesmann does not teach the above-referenced features of the present invention, either explicitly or inherently.

The Official Action alleges that the feature "a calculation unit adapted to calculate an arrival time at each of the specified locations when successively visiting those locations in one of via-sequences while avoiding passing through congested places and/or places which may be congested in accordance with predetermined traffic information, the one of via-sequences being any one of all possible routes via those location" as recited in claim 1 corresponds to Figures 2, 3 and 4 of Mannesmann. (pages 3-4, Paper No. 200806300). The Applicant respectfully disagrees and traverses this allegation. Initially, it is noted that the Official Action concedes that Mannesmann does not disclose predetermined traffic information (page 9, Id.). Further, Mannesmann does not teach generating all possible routes via a plurality of locations which a user

drops in before reaching a destination, either explicitly or inherently. In contrast, in the present invention, a plurality of locations (in which a user drops before reaching a destination) are specified in advance and all via-sequence patterns, in each of which the specified locations are visited once in sequence, are generated.

Therefore, the Applicant respectfully submits that Mannesmann does not teach a route pattern generation unit adapted to generate all via-sequence patterns in each of which the specified locations are visited once in sequence or a calculation unit adapted to calculate an arrival time at each of the specified locations when successively visiting those locations in each of the via-sequence patterns generated by the route pattern generation unit while avoiding passing through congested places and/or places which may be congested in accordance with predetermined traffic information, either explicitly or inherently.

Since Mannesmann does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 6 of the Official Action rejects claims 3-8 as obvious based on Mannesmann. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found

either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art does not teach or suggest all the features of the independent claims, as amended. Independent claim 3 has been amended to recite "a route pattern generation unit adapted to generate all via-sequence patterns in each of which the specified locations are visited once in sequence" and "a search unit adapted to search a route between two successive locations in each of the via-sequence patterns generated by the route pattern generation unit." Independent claim 6 has been amended to recite "generating all via-sequence patterns in each of which the specified locations are visited once in sequence" and "calculating an arrival time at each of the specified locations when successively visiting those locations in each of the via-sequence patterns generated in the generation step while avoiding passing through congested places and/or places which may be congested in accordance with predetermined traffic information." These features are supported in the present specification, for example, at page 22, lines 16-27. The Applicant respectfully submits that Mannesmann does not teach or suggest the above-referenced features of the present invention.

The Official Action concedes that Mannesmann does not teach "a re-search part" (pages 6 and 8, Paper No. 20080630), "a second time calculation unit" (page 6, Id.), "a second judgment unit" (pages 6-7 and 8, Id.) and "predetermined traffic information" (page 9, Id.). The Official Action asserts that these features would have been obvious to one of ordinary skill in the art at the time of the present invention. However, the Applicant respectfully submits that it would not have been obvious to one of ordinary

skill in the art at the time of the present invention to modify Mannesmann to include the above-referenced features of amended independent claims 1, 3 and 6.

The Official Action asserts the following (page 9, Id., italics in original):

Note: Claims 1-5 recite that the statements "adapted to", "operate", "wherein", etc. performs a function is not a positive limitation but only requires the ability to so perform. It doesn't constitute a limitation in any patentable sense.

On the one hand, the Official Action provides the above-referenced note. On the other hand, in the body of the Official Action, the Examiner has reproduced claim features including the clauses beginning with the terms "adapted to," "operate," and "wherein." As such, the record is not clear as to whether the Official Action has further treated the merits of any of the features of the present claims that are preceded by one of the above-referenced terms. In the event the Examiner continues to reject the present claims and to the extent that any features of the present claims are excluded from the Examiner's determination of the scope of the claims, the Applicant respectfully requests clarification of the record and a specific and unambiguous statement as to which features are being considered by the Examiner and which features are not.

Also, as noted in MPEP § 2111.04, the mere inclusion of a term such as "adapted to" does not necessarily mean that features following the term do not have patentable weight. Rather, MPEP § 2111.04 notes that the "determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case."

Further, a basic precept set forth in the MPEP is as follows: "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used" (MPEP § 2173.05(g)). The Applicant respectfully submits that it is not reasonable to read out all features preceded by, for example, the phrase "adapted to" in the present claims.

The Applicant respectfully submits that the present claim terms preceded, for example, by the phrase "adapted to" are, in fact, material to patentability. Thus, these

terms cannot be ignored in ascertaining the scope of the present invention. The Applicant requests that the present claims be evaluated and considered for what they fairly convey to a person of ordinary skill in the pertinent art in the context in which they are used. The Applicant further respectfully submits that Mannesmann does not teach or suggest all the features of the present independent claims including those features that are preceded, for example, by the term "adapted to."

Since Mannesmann does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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